

## **REMARKS**

Claims 1-17 were examined and claims 18-20 were withdrawn. Claim 1 is amended. Claims 21-22 are added.

Claims 1-17 are rejected under 35 U.S.C. § 102(a) based upon an article written by Hong Heather Yu and Wayne Wolf, entitled A Hierarchical Multiresolution Video Shot Transition Detection Scheme, 75 (Nos. 1/2), Computer Vision and Image Understanding, 196 (July/Aug. 1999) (hereinafter referred to as "Yu"). Claims 1-4 and 6-9 are rejected under 35 U.S.C. § 103(a) based upon U.S. Patent No. 5,911,008, issued to Niikura in view of U.S. Patent No. 5,508,750, issued to Hewlett. Claims 10 and 13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Niikura in view of Hewlett and further in view of U.S. Patent No. 5,477,276, issued to Oguro.

## **SPECIFICATION**

The U.S. Patent and Trademark Office (USPTO) objected to the specification for certain informalities. The Applicant has amended the specification according to the Examiner's suggestions except Figure 7 was modified to show the cut transition detector 130 instead of changing the text. The approval of Figure 7 and the withdrawal of the objections to the specification is respectfully requested.

## **REJECTION UNDER 35 U.S.C. § 102**

Claims 1-17 were rejected under 35 U.S.C. § 102(a) as being anticipated by Yu. The Applicant respectfully asserts that the USPTO has failed to meet its burden of proof for this rejection because the USPTO did not set forth the date of Yu. The date is the

"time stated in terms of the day, month, and year." The American Heritage College Dictionary at 353 (3d. ed. 1997). According to the Manual of Patent Examining Procedure (MPEP), a prima facie case of anticipation requires the USPTO to provide, at a minimum, the actual publication date of an article. MPEP, §706.02(a). Specifically, the MPEP states:

The examiner must determine the issue or publication date of the reference so that a proper comparison between the application and reference dates can be made.

Under Protein Foundation Inc. v. Brennen, 260 F.Supp. 519, 521 (D.D.C. 1966), cited by the MPEP, the USPTO may have an even heavier burden of proof since the district court ruled that the one year time period under 35 U.S.C. §102(a) is effective on the date the published article was received by subscribers, not the date the article was published or mailed.

Here, the USPTO apparently assumes that the July/August publication of Yu precedes the July 6, 2000 filing date of the application. It is equally likely that the publication date occurred after July 6, 1999. Accordingly, the Applicant respectfully requests that the USPTO provide the full date for the Yu reference in order to properly compare the application and reference dates. Withdrawal of the rejection of claims 1-17 under 35 U.S.C. §102(a) is respectfully requested.

#### **REJECTION UNDER 35 U.S.C. § 103**

Claims 1-4 and 6-9 are rejected under 35 U.S.C. § 103(a) as obvious based upon Niikura in view of Hewlett. As a preliminary matter, claim 1 has been amended to include "a frequency decomposer...that generates a high frequency signature for each

of said plurality of frames ... and a fade detector that identifies a fade transition using said high frequency signature for a sequence of adjacent frames.” There are two problems with the USPTO’s combination of Niikura and Hewlett. First, neither Niikura, Hewlett, nor Oguro teach or suggest these clauses with respect to the high frequency signature.

Second, the USPTO used broad conclusory statements to explain why the clause from claim 10 is obvious based upon Niikura in view of Hewlett, and further in view of Oguro. In particular, the USPTO stated that:

Oguro teaches how to achieve or create a fade-in, fade-out and scene change effect using both AC and DC frequency components. The Examiner notes that by knowing how a fade is created, one could easily implement an apparatus to detect a fade transition. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to take the apparatus disclosed by Niikura, add the low frequency comparison taught by Hewlett and apply the teachings by Oguro in order to obtain an apparatus that would more efficiently detect scene cuts or shot boundaries.

Office Action dated December 4, 2003, pp. 6-7. A similarly broad conclusory statement was rejected by the Board of Patent Appeals and Interferences (“the Board”) in the case entitled Ex Parte Huang, No. 1997-3338, (Bd. Pat. App & Int. 1997 unpub.) In that case, the examiner stated:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the above references' teachings as taught by Sun et al., Lee et al., and Sandhu et al. because such use of planarized plugs by CMP [chemical mechanical polishing] or etchback and the claimed deposition processes and materials are conventional and obvious as evidenced by Sun et al., Lee et al., and Sandhu et al. to enable the formation of a planarized plug for contact.

Id. In reversing the examiner’s rejection of the pertinent claims, the Board, stated:

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.

This ruling conforms to the Federal Circuit's edict that broad conclusory statements standing alone are not "evidence." In re Dembiczak, 175 F.3d 994, 1000 (Fed. Cir. 1999). Accordingly, merely reciting that an element of a claimed invention is taught by a reference does not establish a motivation to combine references. Since there is no discernible motivation for combining the Oguro reference with Niikura in view of Hewlett, the rejection of claims 1-4, 6-10 and 13 under 35 U.S.C. §103(a) cannot stand as a matter of law.

#### **CONCLUSION**

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt

and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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